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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/048,027	01/28/2002	Toru Karasawa	111796	1264
7590	05/23/2006		EXAMINER	
Oliff & Berridge PO Box 19928 Alexandria, VA 22320			ZHOU, TING	
			ART UNIT	PAPER NUMBER
			2173	

DATE MAILED: 05/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/048,027	KARASAWA ET AL.	
	Examiner	Art Unit	
	Ting Zhou	2173	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6 and 8-37 is/are pending in the application.
- 4a) Of the above claim(s) 11-19 and 22-37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) 4, 6, 8-10 and 20 is/are allowed.
- 6) ☒ Claim(s) 1-3 and 21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
- ☒ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The amendment filed on 6 March 2006 have been received and entered. Claims 1-4, 6 and 8-37 as amended are pending in the application. Claims 11-19 and 22-37 are withdrawn from consideration. Claims 1-4, 6, 8-10 and 20-21 are examined below.

Allowable Subject Matter

2. Claims 4, 6, 8-10 and 20 are allowed.

3. Claim 21 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 101, set forth in this Office action.

4. The following is an examiner's statement of reasons for allowance: The present invention teaches a technique for enabling scenario files and image files for supply to a scenario generating device to be created. Each of the independent claims identifies the distinct feature of a file management area for displaying source files and a selected source file information area for displaying, in a sequence selected by a user, selected source file information representing information of a source file selected sequentially by the user in the file management area; the scenario creating section creates the scenario file indicating a plurality of the selected source files in response to a content of the display in the selected source file information area, the plurality of selected source files including source files of two or more formats; and the selected source file information including page indicating information indicating a page among a plurality of pages included in the selected source file. The closest prior art, Tatsuji JP 8-153104 and Jackson U.S.

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Patent 5,960,444 teaches a file management area for displaying source files and a selected source file information area for displaying, in a sequence selected by a user, selected source file information representing information of a source file selected sequentially by the user in the file management area; the scenario creating section creates the scenario file indicating a plurality of the selected source files in response to a content of the display in the selected source file information area, the plurality of selected source files including source files of two or more formats; and the selected source file information including page indicating information indicating a page included in the selected source file. In the case of the Tatsuji reference, Tatsuji teaches a file management area for displaying source files and a selected source file information area for displaying, in a sequence selected sequentially by a user, selected source file information representing information of a source file selected by the user in the file management area; the scenario creating section creates the scenario file indicating a plurality of the selected source files in response to a content of the display in the selected source file information area; the selected source file information includes page indicating information indicating a page in the selected source file. In the case of the Jackson reference, Jackson teaches source files of two or more formats. However, the prior art fails to teach the displaying selected source file information representing information of a source file in a sequence selected by a user, in the file management, in which the source files includes multiple pages, i.e. a page in a plurality of pages, and thus fails to anticipate or render the above limitations obvious.

5. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue

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fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 3 and 21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The specification of the applicant's invention recites "storage medium" to include "a flexible disk, CD-ROM, DVD, magneto-optical disk, IC card, ROM cartridge, punch card, *printed matter imprinted with symbols such as bar codes*, etc." (page 24 of the specification). The recited "printed matter imprinted with symbols such as bar code" is non-statutory subject matter because it does not necessarily include any computer or computer-related hardware components, and is therefore non-functional descriptive material; in other words, it is a mere arrangement of data with no requisite functionality present to satisfy the practical application requirement.

7. To expedite a complete examination of the instant application, the claims rejected under 35 U.S.C. 101 (nonstatutory) above are further rejected as set forth below in anticipation of the applicant amending these claims to place them within the four statutory categories of invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tatsuji JP 8-153104, and Jackson U.S. Patent 5,960,444.

Referring to claims 1, 2 and 3, Tatsuji teaches a scenario creating device, method and computer-readable storage medium comprising an input section including a pointing device (input part 11 comprising input devices such as a keyboard and mouse) (Tatsuji: paragraphs 0021-0022 and Figure 1), a display section (output monitor) (Tatsuji: paragraphs 0021-0022 and Figure 1), and a scenario creating section for creating the scenario file in accordance with operation of the input section (the editor creates the scenario, or link order of the cards of a presentation for display) (Tatsuji: paragraphs 0025-0032); and wherein the scenario creating section provides a display of an execution icon on the display section for causing the scenario creating section to execute a process (displaying edit icon 102 in Figure 6) for carrying out a list display function) (Tatsuji: paragraphs 0049-0051), a file icon for a source file (as shown in Figure 8, a plurality of cards, or icons for the file of the input document are displayed; the icons, i.e. cards shown in Figure 8 are for the source file made up of the cards) (Tatsuji: paragraphs 0051-0053), and in response to operation of the pointing device, the scenario creating section creates the scenario file of the predetermined format on the basis of the image information (in response to an input document, creating the hypermedia document via assigning information to

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the cards according to the logic structure file and displaying the cards together with the link order defined between them) (Tatsuji: paragraphs 0013, 0015-0017 and 0025-0032), wherein the source file has multiple pages (as shown by the scenario window 201 in Figure 8, the source file is made up of a plurality of pages, i.e. cards 1-12) . However, although Tatsuji teaches reproducing image files and source file including pagewise scenario information and image information, Tatsuji fails to explicitly teach the image file is of a first predetermined format and the source file is of a second predetermined format, the first predetermined format being different from the second predetermined format and dragging and dropping the file icon on the execution icon to create the scenario file. Jackson teaches the creation of an index of cards, i.e. an index of files (Jackson: column 1, lines 38-50 and column 3, lines 26-36) similar to that of Tatsuji. In addition, Jackson further teaches dragging and dropping a file icon onto a target area to create a scenario file by converting files from one predetermined format to another predetermined format, the predetermined formats being different from one another (users can drag and drop an icon representing a bookfile to a targets area in order to index the combined documents; also, bookfiles can be converted from a binary "Maker" file format to a MIF format) (Jackson: column 1, lines 38-50, column 3, lines 25-36 and 61-67, and column 4, lines 58-67). It would have been obvious to one of ordinary skill in the art, having the teachings of Tatsuji and Jackson before him at the time the invention was made, to modify the creation of a scenario file of Tatsuji to include the conversion of a file from a source to a target format and creating an index of files upon a drag and drop operation of a file icon taught by Jackson. One would have been motivated to make such a combination in order to combine a plurality of documents of

varying versions and formats and create an index from the combined documents for easy and convenient access of the documents.

Response to Arguments

9. Applicant's arguments filed 6 March 2006 with regards to claims 1-3 have been fully considered but they are not persuasive:

10. With respect to claims 1-3, the applicant argues that Tatsuji does not disclose the source file has multiple pages. The examiner respectfully disagrees. Upon careful consideration of Tatsuji after the telephone interview with the applicant's representative on March 2, 2006, the examiner respectively asserts that Tatsuji teaches the creation of a scenario file from the source file, which includes a plurality of pages, i.e. the plurality of cards, as shown in Figure 8 and recited in paragraphs 0013-0015. In the remarks made by the applicant on the response received on March 6, 2006, the applicant states that the office action has acknowledged that a plurality of cards represent a plurality of source files. The examiner respectfully clarifies that the plurality of cards taught by Tatsuji represent one source file. For example, as shown by the scenario window 201 in Figure 8, a plurality of "file icons", i.e. cards 1-12, represent the source file made up of the 12 cards. Therefore, the scenario file is created from the plurality of file icons (cards) representing a source file and pagewise scenario, i.e. card-link, information. In other words, the source file has multiple pages, i.e. multiple cards.

Conclusion

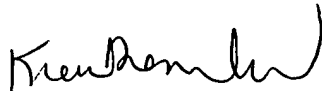
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ting Zhou whose telephone number is (571) 272-4058. The examiner can normally be reached on Monday - Friday 7:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeca can be reached at (571) 272-4048. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TZ


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PRIMARY EXAMINER